



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/875,444 | 06/06/2001 | Bruce R. Baird | 15184.2 | 5041 |

7590

04/28/2004

John C. Stringham
WORKMAN, NYDEGGER & SEELEY
1000 Eagle Gate Tower
60 East South Temple
Salt Lake City, UT 84111

EXAMINER

WOO, ISAAC M

ART UNIT

PAPER NUMBER

2172

DATE MAILED: 04/28/2004

7

Please find below and/or attached an Office communication concerning this application or proceeding.

20

Office Action Summary

Application No.

09/875,444

Applicant(s)

BAIRD ET AL.

Examiner

Isaac M Woo

Art Unit

2172

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 15-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is in response to Applicant's amendment, filed on February 12, 2004 have been considered but are deemed moot in view of new ground of rejections below.
2. Claims 1-2, 7-9, 11-14, 16 are amended. Claims 18-19 are newly added.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims are rejected under 35 U.S.C. 102(b) as being anticipated by Bennett et al (U.S. Patent No. 5,950,194, hereinafter, "Bennett").

With respect to claims 1, 10-11, 15 and 18, Bennett discloses, selecting one or more search terms (75, fig. 3a-b) within a first application (Natural front-End, fog. 3a-b) at a computer, see (105, fig. 7, col. 8, lines 40-55, col. 11, lines 20-61); activating the one or more search terms (75, fig. 3a-b) within the first application, wherein the first application is not a browser application, see (fig. 3a-b, fig. 7, col. 7, lines 37-67 to col. 8, lines 1-39); performing a search based on the one or more search terms in the

Art Unit: 2172

background with a second application at the computer such that the computer remains in a context of the first application (fig. 3a-b, 75, fig. 3a-b are selected texts to be searched) and does not display the second application to a user or view a window of the second application(search engine does not show on, fig. 3a-b); and returning search results to the at least one first application, see (145, fig. 8, 78, fig. 3b, col. 10, lines 1-39, col. 17, lines 1-14).

With respect to claims 2 and 12, Bennett discloses, first application is selected from the group of word processor; spreadsheet, database, image processor; web browser; text recognition; email client, and operating system, text; remote file; sound file; MPEG file and meta data, see (fig. 3a-b, fig. 7, col. 7, lines 37-67 to col. 8, lines 1-39).

With respect to claim 3, Bennett discloses, automatically selecting the one or more search terms pursuant to pre-defined rules, see (fig. 3a-b, fig. 7, col. 7, lines 37-67 to col. 8, lines 1-39).

With respect to claims 4-6, Bennett discloses, automatically selecting the one or more search terms pursuant to pre-defined rules and configuring searching according to a context of the one or more search terms, and storing search results see (fig. 3a-b, fig. 7, col. 7, lines 37-67 to col. 8, lines 1-39).

With respect to claim 7, Bennett discloses, presenting the search results to the user without the user having to application, see (fig. 3b, col. 7, lines 37-67 to col. 8, lines 1-39).

With respect to claim 8, Bennett discloses, search is performed without the user having to exit the at least on first application, see (fig. 3b, col. 7, lines 37-67 to col. 8, lines 1-39).

With respect to claim 9, Bennett discloses, by a user, the search results within the first application, see (fig. 3b, col. 7, lines 37-67 to col. 8, lines 1-39).

With respect to claim 13, Bennett discloses, search by selecting at least one search location, see (105, fig. 7, col. 8, lines 40-55, col. 11, lines 20-61).

With respect to claims 16-17, Bennett discloses, within an application, previewing data that has not been selected by a use within at least one application, see (fig. 3a-b, fig. 7, col. 7, lines 37-67 to col. 8, lines 1-39); selecting a portion of the previewed data as search terms without user input, see (fig. 3a-b, fig. 7, col. 7, lines 37-67 to col. 8, lines 1-39); performing a search based on the portion of the previewed data without user input, see (fig. 3a-b, fig. 7, col. 7, lines 37-67 to col. 8, lines 1-39); caching search results from the search, wherein the search results are readily available to a user, see (fig. 3b, col. 7, lines 37-67 to col. 8, lines 1-39).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett et al (U.S. Patent No. 5,950,194, hereinafter, "Bennett") in view of Chakrabarti (U.S. Patent No. 6,125,361).

With respect to claim 19, Bennett discloses, identifying search data that has been selected in a non-browsing application, the search data including text, see (105, fig. 7, col. 8, lines 40-55, col. 11, lines 20-61); activating the search data by providing the selected search data, wherein the application performs a search on a computer network using the search data and wherein the application is not displayed to a user, see (fig. 3a-b, fig. 7, col. 7, lines 37-67 to col. 8, lines 1-39); receiving search results from the application, see (fig. 3a-b, fig. 7, col. 7, lines 37-67 to col. 8, lines 1-39); and presenting the search results in a context of the non-browsing application such that the user is not required to switch from the application to the non-browsing application, see (fig. 3a-b, fig. 7, col. 7, lines 37-67 to col. 8, lines 1-39). Bennett does not explicitly disclose

browsing application. However, Chakrabarti discloses browsing application discloses, the search engine browser application, see (col. 1, lines 35-45). Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention was made to include browsing application in the system of the Bennett. Because browser is a program which allows a person to read hypertext. The browser gives some means of viewing the contents of nodes (or "pages") and of navigating from one node to another. Thus, the browser is used as a popular web searching engine interface.

Allowable Subject Matter

7. Claim 14 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isaac M Woo whose telephone number is (703) 305-0081. The examiner can normally be reached on 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E Breene can be reached on (703) 305-9790. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

IMW
April 6, 2004


SHAHID ALAM
PRIMARY EXAMINER